

REMARKS

In the Office Action, the Examiner finally rejected Claims 1, 3, and 4 under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Singh. Applicant respectfully requests reconsideration and removal of the rejections.

The Examiner states that “Singh teaches that the use of a festoon accumulator is preferred for use in an unwinding and rewinding device because the festoon allows continuous unwinding of the web thereby maintaining a constant rate of speed and constant amount of tension in the web (column 3, lines 35-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the festoon accumulator of Singh to the apparatus of the admitted prior art to provide a constant tension on the unwinding web.” Applicant avers that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to add the festoon accumulator of Singh to the apparatus of the admitted prior art because Singh teaches away from so doing.

“Where a reference warns against rather than teaches the invention, one cannot be expected to combine it with another teaching.” R. Harmon, *Patents and the Federal Circuit* 179 (6th ed. 2003); *see also In re Fine*, 837 F.2d 1071, 1074-75, 5 USPQ2d 1596 (Fed. Cir. 1988). Singh recognized that “a need ha[d] arisen for a system and method for producing coreless fabric rolls that increase[d] the efficiency and *reduce[d] the amount of movement of system components.*” Column 1, lines 54-57 (emphasis added). Singh also stated that a “technical advantage of [his] invention include[d] *reduced movement of system components, thereby increasing efficiency...*” Column 2, lines 26-28 (emphasis added). In contrast to what Singh taught, applicant’s invention *adds* moving system components to increase efficiency.

Therefore, it would not have been obvious to one skilled in the art at the time the invention was made to use the Singh reference to add a moving component to a different piece of prior art, since the Singh reference explicitly teaches against so doing.

Based on the foregoing, applicant respectfully submits that the present claimed invention is not rendered unpatentable under §103(a) by the Singh reference.

Removal of the rejections based on the Singh reference is therefore requested.

The Examiner then rejected Claim 3, stating that “the location of the embossing rollers and glue applicators would be determined by routine optimization.”

Applicant respectfully requests reconsideration and removal of this ground of rejection. Applicant avers that the present invention is new and unobvious. Therefore, there can be no such thing as “routine” optimization. “Routine” suggests that it has been done before. However, as previously stated, this is a new invention. No previous optimization could have previously been practiced on it. Therefore, applicant requests removal of this ground of rejection.

The Examiner then rejected Claim 4, stating that “the use of independent motors would be obvious to one of ordinary skill in the art because some operations are continuous while others require starting and stopping.” While it is true that some operations require starting and stopping (e.g., the rereeling machine must stop to discharge a finished log. See Abstract), an objective of the present invention was to realize “an apparatus for rewinding paper into rolls discontinuously without stopping unwinding, which overcomes the problems of the prior art..., allowing ‘start-stop’ plants that already exist to be used.” The present invention was reducing the amount of “stopping” that occurred in the prior art. As such, it would not have been obvious to one of ordinary skill in the art to use independent motors. Therefore, applicant requests removal of this ground of rejection.

In light of the foregoing applicant respectfully submits that that the claims of the present application are in proper form for allowance. Favorable consideration and early allowance are therefore respectfully requested and earnestly solicited.

Respectfully submitted,



James V. Costigan
Reg. No. 25,669

MAILING ADDRESS

Hedman & Costigan, P.C.
1185 Avenue of the Americas
New York, NY 10036
(212) 302-8989